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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant : Bowne & Co., Inc.
Serial No. : 76/269,850
Filed : June 11, 2001
Mark : BOWNE GLOBAL SOLUTIONS
Examining Attorney : Judy Grundy
Law Office : 106

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BRIEF ON APPEAL

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I. Introduction

Applicant submits this Brief on Appeal, pursuant to 37 C.F.R. §2.143, from the Final Office Action dated July 10, 2002. Applicant's Notice of Appeal, along with the sum of \$100.00, was submitted within the time dictated by 37 C.F.R. §2.142.

On July 10, 2002, the Examining Attorney issued a final refusal (the "Final Refusal") under Trademark Act Section 2(d), 15 U.S.C. §1052(d). The Examining Attorney refused to register the mark BOWNE GLOBAL SOLUTIONS ("Applicant's Mark") as applied to: printing services, language translation and interpretation services, localization services, namely language translation and interpretation services which incorporate cultural nuances and language dynamics for use in introducing products and services in specific markets all over the world, and written text editing services, namely revising and finalizing documents for others, in International Class 42. Registration was refused on the ground that it is likely to be confused with the mark GLOBAL SOLUTIONS of Registration No. 2,061,051 (the "Cited Mark") as applied to various language translation and interpretation services. Applicant Respectfully submits that there is no likelihood of confusion between the Cited Mark and Applicant's Mark.

II. The Examining Attorney Has Used The Wrong Legal Standard

Applicant believes that one reason the Examining Attorney issued a final refusal may be that the Examining Attorney used the wrong legal standard in evaluating the likelihood of confusion between the Cited Mark and the Applicant's Mark. In the fourth paragraph from the top on page of the Final Refusal, the Examining Attorney wrote:

[The Applicant] has a legal duty to select a mark which is totally dissimilar to trademarks already being used.

Final Refusal at 3, citing Burroughs Wellcome Co. v. Warner-Lambert Co., 203 U.S.P.Q. 191 (T.T.A.B. 1979) (“WELCOME TOUCH” and “WELCOME FEELING” held likely to be confused with previous “WELCOME” for related pharmaceuticals).

Applicant concedes that the Board did use the above language in the Burroughs case, but counters that the overly strict “totally dissimilar” test is not the law, and that such language in Burroughs must be viewed in the context of that case, where there were other factors militating in favor of a finding of confusion.

In comparison, the plain wording of the statute is clear, and the case law is replete with examples which hold exactly the opposite, namely that the Applicant’s obligation is limited to adopting a mark which is not likely to be confused with a previously registered mark, as opposed to a mark which is “completely dissimilar” to any registered mark. T.M.E.P. §1207, citing 15 U.S.C. §1052; See, e.g., Bongrain Int’l (American) Co. v. Delice De France, Inc., 811 F.2d 1479, 1486 (Fed. Cir. 1987) (“the statute refers to likelihood, not mere possibility of, confusion”); Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp., 954 F.2d 713, 717 (Fed. Cir. 1992) (court “not concerned with mere theoretical possibilities of confusion”).

It appears the Examining Attorney here has been unduly restrictive in requiring applicant to show that its mark is “totally dissimilar” to the Cited Mark. There are a large number of marks which are not likely to be confused under the appropriate legal standard, and which have therefore been duly registered by the Trademark Office,

yet which are not “totally dissimilar” to the Cited Mark. It is respectfully submitted that Applicant’s Mark is one such example.

III. There is No Likelihood of Confusion Between the Cited Mark and Applicant’s Mark

In contrast to the “totally dissimilar” test which the Examining Attorney used as the ultimate basis for the Final Refusal, the correct test to be applied in determining likelihood of confusion is articulated in In re E.I. Dupont De Nemours & Co., Inc., 476 F.2d 1375 (C.C.P.A. 1973). This test first looks at the marks themselves for similarity in appearance, sound, connotation and commercial impression (the “Sight, Sound and Meaning Test”), and second, requires that the Examining Attorney compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion is likely.

In determining whether a mark is likely to be confused with another, the marks must be viewed in their entireties and not judged by their individual components. See Rodeo Collection v. West Seventh, 812 F.2d 1215 (9th Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157 (Fed. Cir. 1986); Sears Mortgage Corp. v. Northeast Savings F.A., 24 U.S.P.Q.2d 1227 (T.T.A.B. 1992); Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005 (C.C.P.A. 1981).

Significantly, use of identical, even dominant, words in common does not dictate a finding that marks are confusingly similar. See General Mills, Inc. v. Kellogg Co., 824 F.2d 622, 627 (8th Cir. 1987), citing Freedom Sav. & Loan Assn. v. Way, 757 F.2d 1176, 1183 (11th Cir. 1985). Indeed, “under the overall impression analysis, there is

no rule that confusion is automatically likely if a junior user had a mark which contains in part the whole of another's mark." J. Thomas McCarthy, TRADEMARK AND UNFAIR COMPETITION §24:41 at 91 (4th Ed.). For example, in In re Ferrero, 479 F.2d 1395, 1397 (C.C.P.A. 1973), the Court of Customs and Patent Appeals reversed the T.T.A.B.'s refusal to register applicant's mark TIC TAC based upon a prior registration for TIC TAC TOE. The Court held that "the Board has made too much of the indisputable fact that TIC TAC is two-thirds of TIC TAC TOE and that TIC TAC would 'bring to mind' TIC TAC TOE." In addition, marks have been found to be dissimilar even when they share the same prefix in common. Land O'Lakes, Inc. v. Land O'Frost, Inc., 224 U.S.P.Q. 1022, 1027 (T.T.A.B. 1984)(no likelihood of confusion between LAND O'LAKES and LAND O'FROST). Further, the presence of a common, weak word element is usually not enough support on which to base a finding that confusion likely. Red Carpet Corp. v. Johnstown American Enter., Inc., 7 U.S.P.Q.2d 1404, 1407 (T.T.A.B. 1988), citing Tektronix, Inc. v. Daktronics, Inc., 189 U.S.P.Q. 693 (C.C.P.A. 1976).

A. The Examining Attorney Has Not Evaluated
the Marks in Their Entirety

In conducting the Sight, Sound and Meaning analysis, the Examining Attorney has unfairly dissected Applicant's Mark, focusing on the GLOBAL SOLUTIONS portion of the mark, and incorrectly minimizing the portion of the mark which acts to distinguish Applicant's Mark from the Cited Mark. The Examining Attorney concluded that Applicant has "merely added wording" to the Cited Mark. In basing her refusal on this premise, the Examining Attorney has effectively excluded from her analysis the

BOWNE portion of Applicant's Mark. This type of analytical dissection has been specifically disapproved by the T.T.A.B. and the Federal Circuit in a number of cases. See, e.g., In re Hearst Corp., 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) ("marks must be considered in the way they are used and perceived" and "marks tend to be perceived in their entireties, and all the components thereof must be given appropriate weight"). See also, Opryland USA Inc. v. The Great American Music Show, Inc., 970 F.2d 847, 851 (Fed. Cir. 1992) (no portion of the mark is to be excluded in analyzing similarity). In analyzing Applicant's Mark as "merely adding wording" to the Cited Mark, the Examining Attorney has incorrectly dissected Applicant's Mark and failed to consider the entirety of Applicant's Mark as a whole. When a proper application of the Sight, Sound and Meaning test is made regarding Applicant's Mark in its entirety, confusion is not likely.

B. There is No Likelihood of Confusion Between the Marks
Because the Shared GLOBAL SOLUTIONS Element is Weak

The GLOBAL SOLUTIONS element shared by Applicant's Mark and the Cited Mark has been diluted by third party use in the business services field. Thus, confusion as to source or origin is not likely.

Third party registrations are relevant to assess whether a portion of a mark is weak. Petro Shopping Centers, L.P. v. James River Petroleum, Inc., 130 F.3d 88, 93 (4th Cir. 1997) ("the frequency with which a term is used in other trademark registrations is indeed relevant to the distinctiveness inquiry"); Ocean Bio-Chem, Inc. v. Turner Network Television, Inc., 741 F. Supp. 1546, 1556 (S.D. Fla. 1990) ("extensive

third party registrations are entitled to considerable weight in determining the strength” of a mark); Estee Lauder Inc. v. The Gap, Inc., 108 F.3d 1503, 1511 (2d. Cir. 1997)(no likelihood of confusion between marks in part because of third party registrations and pending applications which shared the common element of the marks at issue).

It is axiomatic that whether a mark is classified as “weak” or “strong” is an element of consideration in determining whether there is a likelihood of confusion among marks. See generally J. Thomas McCarthy, supra, §23:48. It is also true that in comparing marks in their entirety, it is proper to give less weight to the weak portions. For example, the T.T.A.B. has held that there is no likelihood of confusion between the mark KEY for banking services, and other marks for banking containing the word “KEY” since the word itself is widely used in the financial field. In re Hamilton Bank, 222 U.S.P.Q. 174, 177 (T.T.A.B. 1984). See also Stouffer Corp. v. Health Valley Natural Foods, Inc., 1 U.S.P.Q.2d 1900, 1904 (T.T.A.B. 1986)(no likelihood of confusion between LEAN CUISINE and LEAN LIVING, both as applied to food products, since the word “LEAN” is commonly used in conjunction with food).

The same holds true here. There are at least twenty-eight (28) registered or pending marks, in International Class 42, incorporating the words “GLOBAL SOLUTIONS” including:

1. EASSIST GLOBAL SOLUTIONS, Registration No. 2,629,160
2. GLOBAL SOLUTIONS FOR MOSQUITO CONTROL, Registration No. 2,628,878
3. QEK GLOBAL SOLUTIONS, Registration No. 2,657,747

4. YOUR GLOBAL SOLUTIONS, Registration No. 2,430,753
5. SHELL GLOBAL SOLUTIONS, Registration No. 2,660,047
6. HALL-MARK GLOBAL SOLUTIONS, Registration No. 2,603,341
7. METAMOR GLOBAL SOLUTIONS, Registration No. 2,298,812

Each of these registrations issued after the registration of the Cited Mark. These marks illustrate the narrow scope of protection given the GLOBAL SOLUTIONS mark as applied to services in International Class 42, and the recognition given by the Trademark Office of the public's ability to distinguish among relatively close marks in this area.

Accordingly, consumers will be able to distinguish between Applicant's BOWNE GLOBAL SOLUTIONS mark and the Cited Mark, and no confusion is likely.

C. There is No Likelihood of Confusion Under the Sight Sound and Meaning Test

Applicant's Mark BOWNE GLOBAL SOLUTIONS is distinguishable from, and not likely to be confused with, the Cited Mark GLOBAL SOLUTIONS. The two marks are visually and aurally distinguishable, and their commercial impressions are distinct.

1. Applicant's Mark Does Not Look Like the Cited Mark

In Conde Nast Publ'n, Inc. v. M.S. Quality, Inc., 507 F.2d 1404, 1407 (C.C.P.A. 1975), The court held that "COUNTRY VOGUES and VOGUE do not look or sound alike." The court concluded that the only similarity between the marks was that "VOGUE" was part of both marks, and that the dissimilarities between the marks outweighed any similarities. Id. Similarly, in Colgate Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 1402 (C.C.P.A. 1970) the court held that the term "PEAK PERIOD"

did not look confusingly similar to the term "PEAK." The court held:

[t]he difference in appearance and sound of the marks in issue is too obvious to render detailed discussion necessary. In their entirety they neither look or sound alike.

Id.

Here, Applicant's Mark is comprised of three words, while the Cited Mark has only two. In addition, Applicant's Mark features the additional word BOWNE, a prominent and distinguishing house mark which is the subject of U.S. Trademark Registration No. 1, 306,991, and others, and which has been used by Applicant since at least as early as 1775. Courts have routinely found use of a house mark effective to eliminate consumer confusion. Worthington Foods, Inc. v. Kellogg Co., 732 F. Supp. 1417, 1441 (S.D. Ohio 1990) ("the house mark of a company tends to de-emphasize the contested mark as a source of the goods or services"); Genovese Drug Stores, Inc. v. TGC Stores, Inc., 939 F. Supp. 340, 346 (D.N.J. 1996) (parties' marks not held confusingly similar since plaintiff's house slogan juxtaposed with its house mark); Packerware Corp. v. Corning Consume Prods. Co., 895 F. Supp. 1438, 1449 (D. Kan. 1995) (parties' marks held not confusingly similar in light of defendant's prominent display of its house mark).

The use of a house mark is particularly effective to dispel confusion when that house mark is strong and well known. G. Heilman Brewing Co., Inc. v. Anheuser-Busch Inc., 676 F. Supp. 1436, 1470 (E.D. Wisc. 1987) ("the use of a strong house mark virtually precludes confusion between similar marks."), aff'd 873 F.2d 985, 999 (7th Cir. 1989); Pristine Indus., Inc. v. Hallmark Cards, Inc., 753 F. Supp. 140, 145 (citations omitted) ("defendant's use of its own well-known mark would ensure that the goods at

issue would be associated with the defendant and not the plaintiff”).

The BOWNE mark is a strong and well known mark. The BOWNE mark has been used on business-related products and services since 1775, and is widely known by consumers to identify those goods and services. Applicant is the owner of a number of registrations incorporating the BOWNE mark, including U.S. Registration Nos.: 1,306,991 and 1,610,231 for the word mark BOWNE; 1,610,231 and 2,339,685 for the mark BOWNE with design elements; 2,264,443 for the mark BOWNE EMPOWERING INFORMATION; and 2,442,491 for the mark BOWNE EMPOWERING YOUR INFORMATION.

As previously noted in the record of the prosecution of this Application, numerous third parties use the phrase GLOBAL SOLUTIONS in connection with business and communications services, and an internet search on the words “GLOBAL SOLUTIONS” reveals more than 65,000 hits for the phrase. When faced with so many different uses of the same phrase, consumers learn to distinguish between those uses. Thus, consumers will be able to distinguish between BOWNE GLOBAL SOLUTIONS and the Cited Mark.¹ Consumers will recognize the BOWNE name and house mark, and since the BOWNE element is the dominant element in Applicant’s Mark there is not likely to be any confusion with the Cited Mark.

¹Although not entered into the record in this matter, numerous other instances exist of third party uses which support an inference of consumer awareness of BOWNE mark through its prominence in the field of business services through advertisements and citations to BOWNE on various business related websites (Attached A). Further, BOWNE business services are well known as a result of unsolicited media attention. Numerous business periodicals have mentioned the Bowne company and its business services (Attached B).

Accordingly, when the marks are viewed as a whole and not dissected, and due to the visual dissimilarity between Applicant's three-word BOWNE GLOBAL SOLUTIONS and the two-word Cited Mark, the two marks do not look alike and there is no likelihood of confusion.

2. Applicant's Mark Does Not Sound Like the Cited Mark

Applicant's Mark is phonetically different from the Cited Mark. In Bell Lab, Inc. v. Colonial Prods., Inc., 644 F. Supp. 542 (S.D. Fla. 1986), the district court stated that one issue, in comparing two marks, is whether the "aural characteristics [are] easily distinguishable, such that confusing similarity was unlikely." Id. at 546. The court stated that:

[t]he question is whether the pronunciation of the sound [of the challenged mark] generates an auditory response that calls to mind or may be confused with the sound of [the Cited Mark].

Id. The court determined that FINAL FLIP did not sound like FINAL, for similar pest control products. Similarly, BOWNE GLOBAL SOLUTIONS is in fact clearly distinguishable from the Cited Mark. Although Applicant's Mark contains the common word elements GLOBAL and SOLUTIONS, it also contains the initially pronounced BOWNE name, which causes the consumer to not only speak an additional word, but a name that is distinct and recognizable.

3. Applicant's Mark Conveys a Distinct Commercial Impression

In Po Folks, Inc. v. Kountry Folks Restaurants, Inc., 231 U.S.P.Q. 313 (T.T.A.B. 1986), the Trademark Trial and Appeal Board held that although two

marks contained the word "FOLKS", a different commercial impression was created in each mark by combining "FOLKS" with a different word. Similarly, in Smith v. Tobacco By-Products Chemical Corp., 113 U.S.P.Q. 339 (C.C.P.A. 1975), the court held that the different meaning conveyed by GREEN LEAF and BLACK LEAF for plant spray created an additional distinction in showing that there was no likelihood of confusion between the two marks.

Here, although both marks contain the words "GLOBAL SOLUTIONS", Applicant's Mark combines those words with the well known BOWNE name. The name BOWNE in combination with GLOBAL SOLUTIONS calls to mind a long tradition of worldwide business printing and other services, and creates a commercial impression distinct from the more vague impression of international problem solving created by the Cited Mark. The different commercial impressions created by the marks is sufficient to avoid any likelihood of confusion.

IV. Registration Should Not be Barred on the Grounds That the Respective Marks are used on Similar Services

The fact that Applicant's Mark and the Cited Mark are applied to similar services should not preclude registration of Applicant's Mark, since the differences in the entirety of each mark would render any consumer confusion unlikely.

In The Land-O-Nod Co. v. Paulison, 220 U.S.P.Q. 61, 67 (T.T.A.B. 1983), the Board held that CHIRO-MATIC was not confusingly similar to CHIROPRACTIC, despite the fact that the marks were used for identical goods, i.e., mattresses and bed springs, and despite the fact that both marks contained the term CHIRO, suggestive of

bedding designed to provide healthful support to the body. Similarly, in In re Bed & Breakfast Registry, 791 F.2d 157, the Federal Circuit held that the applicant's service mark BED & BREAKFAST REGISTRY for making lodging reservations in private homes was not confusingly similar in sight, sound or meaning to opposer's service mark BED & BREAKFAST INTERNATIONAL, even though the services were similar. Id. In so holding, the Court stated that "[marks] are not rendered confusingly similar merely because they share the words 'bed' and 'breakfast.'" Id. at 159. See also Ferro Corp. v. Nicofibers, Inc., 196 U.S.P.Q. 41, 45 (T.T.A.B. 1977)(UNIFORMAT and CONFORMAT sufficiently different in significance, sound and appearance despite the fact that both used for fiber glass for reinforcing plastic); Iodent Chem. Co. v. Dart Drug Corp., 207 U.S.P.Q. 602 (T.T.A.B. 1980)(BIODENT and IODENT not confusingly similar for denture cleanser and dental care products)

In the above-referenced cases the federal courts and the Trademark Trial and Appeal Board have held that registration should not be denied automatically because two marks share similar words and are applied to similar services. Therefore, in the present case, Applicant's BOWNE GLOBAL SOLUTIONS mark should not be denied registration on the basis that it shares the words GLOBAL SOLUTIONS with the Cited Mark, and is used in connection with services which are similar to those offered under the Cited Mark.

V. Conclusion

In view of the foregoing, Applicant respectfully submits that the Examining Attorney's refusal to register Applicant's BOWNE GLOBAL SOLUTIONS mark is incorrect,

and that Applicant's Mark should be deemed allowable and passed to publication.

Respectfully submitted,

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